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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,779	06/13/2001	Masahiro Shioi	55684(551)	6589
21874	7590	03/09/2004	EXAMINER	
EDWARDS & ANGELL, LLP			ALAM, SHAHID AL	
P.O. BOX 55874			ART UNIT	
BOSTON, MA 02205			PAPER NUMBER	

2172

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,779

Applicant(s)

SHIOI ET AL.

Examiner

Shahid Al Alam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

1. Claims 16 – 34 are pending in this Office action.

Information Disclosure Statement

2. The reference cited in information disclosure statement (IDS), Paper Number 6, have been considered by the examiner.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 16, 17, 19 – 27 and 29 – 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent 06195880 A issued to Kawai Osamu et al. and in view of Japanese Patent 07122040 A issued to Hara Mitsuhiko.

With respect to claims 16, 19, 22 and 29, Kawai Osamu teaches generating said index information including a source identifier expressing a source having one or more of said management units associated with said multimedia file as a title frame, positions of a leading frame and tail frame of said title frame in said source, and a position of a reference frame for decoding said leading frame (*a multimedia file management method and management device managing multimedia files using index information, wherein multimedia data of multimedia files can be managed for each predetermined management unit, one or more management units relating to multimedia files are designated as title frames, index information including positional information is generated and added to the multimedia files, which are recorded on a recording medium; see abstract, full text, Figures 1 – 10*).

Kawai Osamu does not explicitly teach recording said index information onto a recording medium, attaching said index information to said multimedia file as claimed. Hara Mitsuhiko teaches claimed recording said index information onto a recording medium, attaching said index information to said multimedia file (*a management method and management device designating as index information positional information of moving images at predetermined intervals, and recording the same; see abstract, paragraph number 0058, Figures 2, 13, 14*).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was to adopt, in the invention described in Kawai Osamu's document with the technical means described in Hara Mitsuhiko's document for designating as index information positional information of moving images at predetermined intervals, and recording the same, and upon doing such, selecting as index information, the appropriate information from among the well-know information that the moving image has, such as positional information or encryption information.

As to claim 17, generating index information includes a step of generating a plurality of pieces of index information and said recording step includes a step of recording said plurality of pieces of index information and information for specifying the number of said pieces of index information onto a recording medium, attaching said plurality of pieces of index information and said information for specifying the number of said pieces of index information to said multimedia file (abstract, full text, Figures 1 – 10; Kawai Osamu and abstract, paragraph number 0058, Figures 2, 13, 14; Hara Mitsuhiko).

The subject matter of claims 20 – 21 are rejected in the analysis above in claims 16 and 17 and these claims are rejected on that basis.

The subject matter of claims 23 – 27 are rejected in the analysis above in claims 16 - 17 and these claims are rejected on that basis.

The subject matter of claims 30 – 32 are rejected in the analysis above in claims 16 - 17 and these claims are rejected on that basis.

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The subject matter of claims 33 and 34 are rejected in the analysis above in claim 16 and these claims are rejected on that basis.

Allowable Subject Matter

4. Claims 18 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter: the prior art teaches the general state of the art in the relevant technical field, and they describe the above matter; however, none of the documents teaches all of the claimed limitation as described in claims 18 and 28.


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Contact Information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (703) 305-2358. The examiner can normally be reached on Monday-Thursday 8:00 A.M. - 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Shahid Al Alam
Primary Examiner
Art Unit 2172

8 March 2004